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In re Application of
HATANO et al.
Serial No.: 10/576,253
Int'l App.: PCT/JP04/15993
Int'l Filing Date: 28 October 2004
Priority Date: 28 October 2003
Attorney's Docket No.: 127737
For: PULSE GENERATOR CIRCUIT

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: DECISION ON
:
: PETITION
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: UNDER 37 CFR 1.137(b)
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This application is before the PCT Legal Office for consideration of applicant's petition to revive under 37 CFR 1.137(b) international application no. PCT/JP04/15993 filed in the United States Patent and Trademark Office (USPTO) on 18 April 2006.

On 28 October 2004, applicant filed international application PCT/JP04/15993, which claimed priority of an earlier Japanese application filed 28 October 2003. The deadline for entry into national stage expired thirty months after the priority date or by midnight on 28 April 2006.

On 18 January 2005, applicant filed a request to withdraw the U.S. designation in the Japan Receiving Office. Pursuant to PCT Rule 90*bis*.2, the withdrawal was effective upon receipt in the Japan Receiving Office.

On 18 April 2006, applicant filed a petition to revive under 37 CFR 1.137(b) which was accompanied by a Transmittal letter requesting filing the international application pursuant to 35 U.S.C. 371. These papers were assigned serial no. 10/576,253.

DISCUSSION

Under the Patent Cooperation Treaty (PCT), the designation of States is the indication of Contracting States in and for which applicant may seek protection for his invention. For international applications filed on, or after 1 January 2004, the filing of the request automatically constitutes the designation of all Contracting States that are bound by the Treaty on the international filing date. See Articles 4(1)(ii), 11(1)(iii)(b) and Rule 4.9(a).

The applicant may withdraw the designation of any State by a notice addressed to the International Bureau or to the Receiving Office. Such withdrawal is free of charge. The notice of withdrawal must be signed by all the applicants or where an agent or common representative is appointed, signed by such representative. See PCT Rule 90*bis*.2 and 90*bis*.5.

Petitioner explains that "on January 18, 2005, the U.S. designation was inadvertently and unintentionally withdrawn, leading to abandonment of the U.S. national stage". According to Petitioner, the office secretary prepared, stamped and filed the Withdrawal of Designation listing the U.S., rather than the intended withdrawal of the designation of Japan. Petitioner further explains that "the Withdrawal of Designation was forwarded by registered mail to the Japan Patent Office on January 17, 2005, and received by the Japan Patent Office on January 18, 2005." The withdrawal of Designation of the U.S. was accepted by the Japan Patent Office on 18 January

2005 and becomes effective upon receipt. Petitioner now requests revival of international application PCT/JP04/15993, as to the United States abandoned under PCT Rule 90*bis*.2.

Pursuant to PCT Rule 90*bis*.2(b), the withdrawal of the designation of a State means withdrawal of the designation for the purpose of obtaining a national patent. In the instance case, applicant explains that his appointed agent signed a notice of withdrawal of designation of the U.S. on behalf of the applicant. The withdrawal of the designation of the U.S. was requested by applicant's agent and accepted by the Japan Patent Office, which withdrawal became effective upon receipt.

Petitioner did not provide a statement from the Japanese Receiving Office regarding non-compliance with PCT Rule 92, which requires the signature of the applicant in the course of the international procedure.

The Patent Cooperation Treaty Articles, Rule and Administrative Instructions govern the international application process. The Treaty has no provision for revival of an international application where the designation of a State has been withdrawn. Nor has Petitioner relied on any such provision to revive the international application abandoned by withdrawal of the designation. The filing of the withdrawal of the U.S. designation, while inadvertent, cannot be considered unintentional. Petitioner acknowledges that the request for the withdrawal of the U.S. designation was clear and the Japan Patent Office properly accepted such withdrawal under the PCT Rules. In doing so, international application PCT/JP04/15993 was withdrawn for the purpose of filing a national patent in the United States. The petition under 37 CFR 1.137(b) to revive the international application is dismissed.


Petitioner's arguments in reliance on 35 U.S.C. 366 are misplaced and unconvincing. There is no provision under the PCT or in U.S. national law for reviving or reinstating a designation that is withdrawn. Petitioner arguments that the petition to revive be considered as having been made prior to 18 January 2006, when the withdrawal of designation of the U.S. became effective, are also unconvincing. The Office cannot consider a petition to be filed before its receipt date.

Based upon applicant's explanation, applicant may wish to bring this matter to the attention of the Japanese Receiving Office for relief; that is, for the Japan Patent Office to consider the withdrawal of the U.S. designation not to have been made. Statements from Japanese agent and the secretary, who submitted the request to withdraw the designation, would be important to consider.

CONCLUSION

Applicant's petition to revive international application no. PCT/JP04/15993 under 37 CFR 1.137(b) is **DISMISSED WITHOUT PREJUDICE**.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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